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means for receiving identification means different
from said first coupon that includes identification
5 information associated with the payee of said check amount.

REMARKS

Initially, the Examiner has objected to the drawings under 37 C.F.R. § 1.83(a) on the grounds that the "means for positioning check" are not disclosed in the drawings. This basis for objection has been obviated by the cancellation of this claim. By this cancellation, the rejection of Claim 40 under 35 U.S.C. § 112 has also been rendered moot.

Claims 7, 12, 15 and 29 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite. It is argued that the word "predetermined" renders these claims indefinite. Applicant respectfully disagrees since this term is often used in claim language and refers to a condition or state that is known or has been previously established. Regardless, this term has been deleted from these claims.

With respect to the substantive rejection of the claims, all of the claims, except Claims 12-21, have been rejected under 35 U.S.C. § 102(b) or § 103 as being anticipated or rendered obvious by the patent to Mindrum, et al. (U.S. 4,723,212). Claims 7, 23, 33 and 39-41 have been cancelled. Each of the independent Claims 1, 12, 22 and 38 has been amended, as well as several of the dependent claims, to emphasize the patentable aspects of the present invention. Reconsideration of the

substantive rejection of these claims is respectfully requested, in view of such amendments, together with the following clarifying points and arguments.

The present invention is directed to a method for providing and redeeming coupons. The coupons of the present invention are identified as exchange coupons that are differentiable from conventional coupons that typically include product, price and expiration information. Applicant's method and apparatus are characterized by the generation of an exchange coupon from a conventional coupon and the redemption of the exchange coupon but not the redemption of the conventional coupon. A subcombination invention relates to the redemption of the coupon that is differentiable from other coupons and involves the use of a check writer system for printing a check based on the redeemed coupon information and the purchasing of a product associated with the coupon, and in which the payor of the check is not the seller of the product.

The prior art, on the other hand, discloses substantially different apparatus and methodology for generating and redeeming coupons. In the Mindrum, et al. patent, which is relied upon by the Examiner, a method is disclosed that involves the printing of a coupon after a product is purchased. That is, after the purchaser or consumer has purchased all desired products, a determination is made as to what coupon information is to be generated on a coupon that is to be provided to this purchaser. In deciding on the coupon information, the Mindrum, et al. system

takes into account the products that were purchased by the purchaser and generates a coupon for a competitive product that is available from a competitor. In accordance with this method also, the coupon that is generated and printed is independent of whether or not one or more coupons was redeemed. That is, even if no coupon was redeemed by the purchaser, a coupon is still outputted after the purchase transaction. The Mindrum, et al. system also responds to all coupons and does not differentiate between coupons in connection with its operation in printing a coupon after the purchase. Significantly also, the prior art discloses deducting coupon amounts from the purchase price to be paid by the consumer. A check is not printed using a check writer system from which the consumer can receive cash after the check is cashed by a bank or other cashing establishment.

These key differences are brought out in the amended claims. With reference to Claim 1, it calls for, among other things, inputting a first conventional coupon to an apparatus and outputting by the apparatus a first exchange coupon that has product information for a second product. The outputting of the exchange coupon depends upon receipt of the first conventional coupon. In contrast, the Mindrum, et al. system describes a process for printing a coupon after products are purchased by a consumer. The printing of this coupon is not dependent upon receipt of another coupon. In fact, the printing of the coupon by the system can occur without any coupons being redeemed at the time of the purchase transaction.

Amended Claim 1 also calls for the steps of purchasing a second product that is associated with the first exchange coupon, which is different from the first product associated with the conventional coupon. The method of the present invention also recites the steps of ascertaining that the second product was purchased and redeeming the first exchange coupon and not redeeming the first conventional coupon. The redeeming step occurs after the outputting step. In contradistinction, the Mindrum, et al. system involves the purchasing of a product that is associated with a conventional coupon and redeeming this same coupon. After the purchase transaction is completed, the consumer then has to begin another purchase transaction, if he or she wishes to redeem this newly-generated coupon. That is, unlike the claimed invention, not only is this first coupon redeemed, it is also redeemed before, not after, the generating of the new coupon.

If the rejection of Claim 1, as now amended, should be maintained, it is respectfully requested that it be pointed out with particularity how each and every step, including the identified sequence of steps, is taught or suggested by the Mindrum, et al. process, or any other prior art of record. Unless a prima facie case can be made to that effect, it is submitted that Claim 1 should be allowed.

Claims 2-6 and 8-11 are dependent claims, each depending from independent method Claim 1 and are allowable for the same reasons. Each of these claims recites further patentable aspects of the methodology of the present invention. Claim 2 requires the

inputting step to include the receiving of identification information. In a preferred embodiment, the user or consumer has an identification card or means that is provided to the apparatus and can be used in deciding on the content of the exchange coupon. Claims 3 and 4 are directed to checking whether or not the inputted coupon is an exchange coupon and, according to Claim 4, not generating any exchange coupon for an exchange coupon that is inputted to the apparatus. This methodology emphasizes the step that distinguishes regular or conventional coupons from the exchange coupons of the present invention. Similarly, the prior art fails to suggest such a differentiating step. Claims 5 and 6 also relate to the controlling of the inputted coupon. Claim 5 recites that the inputted coupon is rendered unredeemable and Claim 6 determines whether or not magnetic ink is provided. None of the prior art of record discloses the particular limitation of checking whether or not magnetic ink is present. Claim 9 includes the step of printing the second product information on the first exchange coupon, with the second product information being determined independently of the first product information. In contrast, the Mindrum, et al. system does rely on and does depend on the products being purchased by the consumer as part of the consumer's purchase transaction. Claims 10 and 11 further recite the steps of receiving cash for the exchange coupon that was redeemed. The prior art is seriously deficient in even suggesting these claimed steps. Unlike applicant's method, the prior art teaches and suggests an entirely different way of handling the

monetary discounts associated with redeemed coupons. Based on each of these further patentable differences, dependent claims 2-6 and 8-11 should be allowed.

Claim 12 is another independent method claim directed to a subcombination invention. This claim includes the step of providing a first coupon having differentiation means for distinguishing the first coupon from conventional coupons. In contrast, the prior art of record including the Mindrum, et al. patent, have the essential characteristic of providing or using coupons that are conventional or interchangeable with each other so that there is no differentiation among them. Claim 12 also recites the step of purchasing a first product from a seller that has a check writer system. In contradistinction, the prior art teaches purchasing a first product associated with a first coupon from any seller that has the first product. Typically, the seller is reimbursed by the manufacturer of the first product after the first product is purchased and the coupon redeemed. Consequently, there is no teaching or suggestion in the prior art of the seller having a check writer system. Claim 12 also requires a step of printing a check using the check writer system. The amount on the check is determined using the first product information. The check identifies a payor different from the seller of the first product. Not only does the prior art including the Mindrum, et al. patent fail to disclose a check writer system, such prior art completely lacks any teaching or suggestion of having a payor of the check being different from the seller. This payor may be the

manufacturer of the product, supplier of the coupons, or may be a single entity that handles all of the checks, regardless of who manufactured the product for which the check was generated or who supplied the coupons. The prior art, on the other hand, teaches and suggests a completely different methodology in that the coupon discount is deducted from the cost of the purchased product. A separate check is not generated.

Lastly, Claim 12, as well as dependent Claims 13-21, were not substantively rejected by the Examiner in the Action. This further supports the patentability of the amended claims that emphasize the features that patentably distinguish this method claim from the prior art.

In view of the deletion of the term "predetermined" from this claim, together with the clarifying amendments made to the claim, Claim 12 should now be allowed.

Dependent Claims 13-21 are further method claims, each of which depends, directly or indirectly, from allowable Claim 12. Each of these claims defines further patentable subject matter and, particularly when taken together with the patentable limitations recited in Claim 12, each of these dependent claims should also be allowed.

Claim 22 is an independent system or apparatus claim that is similar in scope to method Claim 1. Claim 1 calls for, among other things, a first means for receiving a first coupon. The first means includes means for ascertaining whether or not the first coupon is an exchange coupon. The first exchange coupon includes

means for differentiating the first exchange coupon from a coupon that is not an exchange coupon. Unlike the claimed invention, the Mindrum, et al. system lacks any suggestion of any kind of means that distinguishes between certain kinds of coupons. Indeed, a necessary aspect of the Mindrum, et al. system is that it be able to handle all discount coupons. Claim 22 further states that the first exchange coupon is not generated when the first means receives an exchange coupon. Conversely, the Mindrum, et al. system does produce a coupon, without regard to the type or class of coupon. That is, the Mindrum, et al. system does not differentiate between "exchange" coupons and "regular or conventional" coupons. This is a key feature of Applicant's invention in that Applicant's system prevents a user or consumer from continuing to input exchange coupons until the user receives an exchange coupon that he or she finds is more worthwhile or desirable.

Claim 22 further defines the second means as outputting the first exchange coupon in response to ascertaining that the first coupon was received by the first means, wherein the outputting of the first exchange coupon is dependent on the first coupon being received. As pointed out in the discussion of Claim 1, the Mindrum, et al. system provides a printed coupon after a purchase transaction independently of, not dependent on, a first coupon being received. That is, regardless of whether or not a coupon is redeemed, the Mindrum, et al. system is able to print a coupon after the purchase transaction. Likewise, Claim 22 requires means

for redeeming the first exchange coupon but not redeeming the first coupon from which the exchange coupon was generated. As set out in the discussion of Claim 1, an important aspect of the present invention is to permit redemption of an exchange coupon and not a conventional coupon that was inputted as part of the generation of the exchange coupon.

In light of the combination of these numerous patentable distinctions, unless a persuasive showing can be made that the prior art teaches or suggests such a combination, Claim 22 should now be allowed.

Claims 24-32 and 34-37 are dependent claims, each of which depends from dependent Claim 22 and are allowable for the same reasons. Claims 24-27 further define the first means to include a means for ascertaining as to whether or not the inputted coupon has a certain type of ink in connection with determining whether or not the coupon should be accepted for exchange. Claims 28-30 are directed to limiting the second means. Claim 29 requires that the second means include computer means for selecting product information for printing on the exchange coupon in a sequential manner. In one embodiment, the product information to be printed on an exchange coupon is provided in memory at defined locations that are accessed in a sequential order so that no product information is printed more often than other product information. Claims 31 and 32 further limit the fourth means. Claim 34 defines the second means as including means for rendering the first coupon unredeemable before the first coupon is able to be redeemed by

purchasing a product identified on the first coupon and the fourth means includes means for rendering the first exchange coupon unacceptable for further redemption after the first exchange coupon has been redeemed. This claim emphasizes the patentable aspects of the present invention in which the first exchange coupon is redeemed and not the first coupon that was inputted into the apparatus for generating the first exchange coupon. Claim 35 limits the content of the first exchange coupon by requiring that it have an expiration no greater than the day following the day on which the first exchange coupon was generated. This patentable limitation emphasizes the nature of the coupon being generated in that it is to be generated before a purchase transaction so that the consumer has incentive to use the coupon immediately, unlike the prior art that teaches a relatively long period before expiration. In particular, the Mindrum, et al. system teaches generating a coupon after a purchase transaction, which would have an expiration date longer into the future. Claim 36 further defines the means for printing as printing a second check, which is different from the first check but is printed at about the same time using random generator means. This claim further limits the patentable feature of printing a check to be cashed as requiring the printing of a second check. This second check may be based on a bonus that is paid on a random basis to encourage usage of the exchange coupon. Claim 37 is the last dependent claim that depends from Claim 22 and requires means for obtaining identification information from identification means that is different from the

first coupon that is inputted for exchange. Additionally, the fourth means includes means for receiving identification information that is different from the means for obtaining which obtains such identification information before the first exchange coupon is redeemed. In contrast, the prior art lacks any suggestion of having two different means for obtaining or receiving identification information. Moreover, the identification information is obtained by the first means before the first exchange coupon is redeemed since the first exchange coupon is generated, in this embodiment, at essentially the same time the identification information is obtained. Based on the foregoing patentable distinctions, dependent Claims 24-32 and 34-37 should be allowed.

Claim 38 is the last independent claim directed to an apparatus for redeeming a coupon. This claim is similar in scope to method Claim 12 and is allowable for the same reasons. Claim 38 recites a scanning means for reading a first coupon with the first coupon including means, other than the first product and expiration information for providing information that distinguishes this first coupon from other coupons that are unacceptable for redemption. Dissimilarly, the Mindrum, et al. patent discloses a system that is intended to be responsive to all coupons and fails to include any means for differentiating between coupons. Claim 38 also requires printing means that is responsive to the comparing means for providing a check in an amount based on the first product information. The payor of the check amount is different from the

seller of the first product. In contrast to the claimed invention, no such printing means is disclosed by the Mindrum, et al. system or any other prior art of record. There is also no teaching of a printing means that is responsive to comparing means. And, there is not even a suggestion that the check generated by the printing means has a payor of the check that is different from the seller of the product for which the check is generated. Instead, the prior art teaches the conventional and well-known methodology of including the amount of the coupon discount in the determination of the amount to be paid by the purchaser for the product or products that are part of the purchase transaction.

In rejecting this claim, it is urged that these patentable limitations are obvious. Applicant respectfully disagrees. Redemption of discount coupons has been a mainstay in the marketplace, in accordance with well-established redemption techniques and processes. Applicant is not the first to create or invent coupons for redemption and is not the first to devise or propose apparatus and method for redeeming a discount coupon. However, Applicant has devised a new way and new apparatus for redeeming certain coupons. Patentable subject matter is commonly based on new and non-obvious "ways" of solving a problem and/or implementing one or more functions. That is exactly what Applicant has accomplished by the invention of Claim 38. More specifically, in accordance with Applicant's "way," means are provided for differentiating certain types of coupons and printing means are provided responsive to comparing means for printing a check and in

which the payor of the check is different from the seller. These aspects of the present invention result in important advantages. First, the consumer is able to receive cash, which is a substantial motivation or incentive in using the coupon. Secondly, because the payor of the printed check is an entity other than the seller, the seller is freed from the burdensome process of being so directly involved in the redemption of the coupon and avoids having to wait until the manufacturer reimburses the seller for the amount reflected in the coupon.

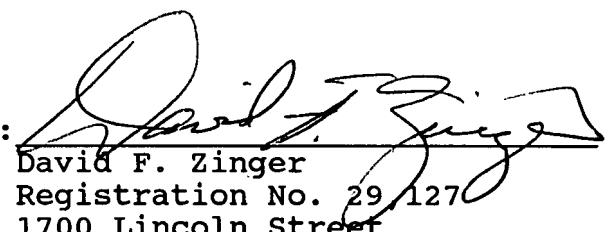
Based on such patentable distinctions and the substantial grounds for supporting the lack of obviousness of the invention defined in Claim 38, this claim should also be allowed.

Finally, consideration of newly added Claims 42 and 43 is requested. Claim 42 further defines the payor of the check to be identified on the check and to be the supplier of the first coupon. In one embodiment, the supplier might be an entity that is responsible for the redemption of all exchange coupons, regardless of the source of the product. Claim 43 further defines the apparatus to include means for receiving identification means that is different from the first coupon. The identification means has identification information related to the payee of the check amount. None of the prior art of record teaches or suggests these further important patentable limitations. Hence, Claims 42 and 43 should also be allowed.

A sincere effort has been made to place this application in condition for allowance. Early notice of such allowance is, therefore, earnestly solicited.

Respectfully submitted,

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